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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,171	12/17/1999	KARL L. GINTER	7451.0005-03	9850

22852 7590 06/07/2004

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EXAMINER

DARROW, JUSTIN T

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/466,171

Applicant(s)

GINTER ET AL.

Examiner

Justin T. Darrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 21-71 is/are pending in the application.
- 4a) Of the above claim(s) 52-71 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-36 and 42-51 is/are allowed.
- 6) ☒ Claim(s) 1 and 37-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 and 21-71 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6.7</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-74 have been presented for examination. Claims 2-20 have been canceled and new claims 21-74 have been added in a preliminary amendment filed 12/17/1999. Claims 72-74 have been canceled in a preliminary amendment filed 03/29/2002. Claims 1 and 21-51 have been elected without traverse and claims 52-71 have been withdrawn from consideration in a response to restriction requirement filed 03/11/2004. Claims 1 and 21-51 have been examined.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 21-51, drawn to a distributed commerce utility, a secure communications system, a method of routing a secure container, a method of generating a secure container, a method of generating a rule set associated with a secure container, a secure checkpoint, and a network, classified in class 713, subclass 193.
- II. Claims 52-71, drawn to a first digital certificate, a digital certifying authority, a virtual distribution environment administration node, and a method of generating a first virtual entity certificate, classified in class 713, subclass 156.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §§ 806.05(c) I. and III.). In

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the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claim 52 recites a digital certificate with issuer identification information and liability protection information, not incorporated in evidence claim 32. The subcombination has separate utility such as issuing a digital certificate for an individual (see claim 61), rather than for a secure container (see claim 32). Therefore, restriction for examination purposes as indicated is proper.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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7. Applicant's election without traverse of Group I, claims 1 and 21-51 in Paper No. 17, filed 03/11/2004, is acknowledged.

***Priority***

8. Acknowledgment is made that the instant application is a continuation of Application No. 09/426,764, filed 10/26/1999, which is a continuation of Application No. 09/398,665, filed 09/17/1999, which is a continuation of Application No. 08/699,712, filed 08/12/1996, now abandoned, which is a continuation-in-part of Application No. 08/388,107, filed 02/13/1995, now abandoned.

***Drawings***

9. The drawings filed on 12/17/1999 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. Formal drawings with corrections must be made in reply to this Office action. See 37 CFR 1.85(a).

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 37-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

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the inventors, at the time the application was filed, had possession of the claimed invention. See MPEP § 2106.01 and *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983). If the specification merely describes in an unspecified way the literal claim language, the written description requirement is not satisfied for a claim that recites some mechanism or step which is a part of the invention and which performs a function incorporating this literal claim language. See *Kaslow*, 217 USPQ at 1096. Independent claim 37 recites the limitation, “generating a rule set specifying a level of insurance dependent, at least in part, on use of a specified secure checkpoint route.”

The specification discloses the Commerce Utility System combining certifying authority services with usage clearing services that is especially useful in issuing digital certificates and then tracking the usage of the certificates in order to evaluate risks, potential liability, and insurance costs (see specification, page 62, lines 13-19 and figure 7A, items 90C, 500, and 300f).

Although the specification describes tracking usage of certificates to evaluate risks, potential liability, and insurance costs, it does not reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter of the generating step of independent claim 37. See *In re Edwards*, 558 F.2d 1349, 196 USPQ 465 (C.C.P.A. 1978).

12. Claims 37-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See MPEP § 2164.01 and *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). This disclosure is insufficient to satisfy the *Wands* factors (F) the amount of direction provided by the inventors and (G) the existence of a working example. See MPEP § 2164.01(a). If no particular

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description of the various output signals from systems or of the operative relationship between them to utilize such signals is set forth, the application might be regarded as leaving significant operative relationships to be determined from the mathematical equations set out, the adequacy of the disclosure is insufficient to enable a person of ordinary skill in the art to make and use method defined in the claims. See *In re Brown*, 177 USPQ 691, 694 (C.C.P.A. 1973). In the instant application, independent claim 37 recites the limitation, “generating a rule set specifying a level of insurance dependent, at least in part, on use of a specified secure checkpoint route.”

The specification discloses the Commerce Utility System combining certifying authority services with usage clearing services that is especially useful in issuing digital certificates and then tracking the usage of the certificates in order to evaluate risks, potential liability, and insurance costs (see specification, page 62, lines 13-19 and figure 7A, items 90C, 500, and 300f). Because the specification does provides neither direction nor a working example of an operative relationship among a rule set, a level of insurance, and the use of a specified checkpoint route, the disclosure does not satisfy the enablement requirement for the generating step of independent claim 37.

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Boebert et al., U.S. Patent No. 4,713,753.

Boebert et al. illustrate a distributed commerce utility comprising: at least one commerce utility system providing a secure execution space (see column 7, lines 52-57; figure 3, item 33; secure processor), performing at least one component based service function, including at least one secure component for execution within the secure execution space (see column 7, lines 62-68; column 8, lines 1-7; figure 3, items 332 and 335; security policy unit which stores the security policy and computes allowed access modes for a user entity operating on an ordinary data object) and providing administrative and support services to electronic community participants (see column 7, lines 56-62; figure 3, item 20; user entity communicating through a terminal).



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15. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Stefik et al., U.S. Patent No. 5,634,012A.

As per claim 1, Stefik et al. describe a distributed commerce utility comprising:

At least one commerce utility system providing a secure execution space performing at least one component based service function comprising at least one secure component for execution within the secure execution space (see column 14, lines 52-61; figure 13, items 1301, 1302, and 1305; a repository with a user interface and a processor; see column 16, lines 7-15; a repository suitable for holding a digital work requiring elaborate security measures that would have physical integrity and verifying authorization before use; see column 38, lines 49-58; after the server checks the validity and compatibility of the printer with specification in the right of a digital work, the work contents can be printed in the printer repository);

As communications facility permitting the commerce utility system to communicate secure control information with at least some of the electronic community participants with whom it is providing administrative and support services (see column 14, lines 52-61; figure 13, items 1301, 1302, and 1305; a repository with a user interface and a processor; see column 38, lines 43-48; the requestor sends the server a message to initiate printing a digital work).

***Allowable Subject Matter***

16. Claims 21-36 and 42-51 are allowed.

17. The following is an examiner's statement of reasons for allowance:

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Claims 21-26 are drawn to secure communications system. The closest prior art, Stefik et al., U.S. Patent No. 5,629,980 A, discloses a similar communications system.

Stefik et al. discloses a secure communications system including:

a first checkpoint (see column 14, lines 7-13; figure 12; a repository) including:

a switch including means for receipt and routing of digital information (see column 14, lines 44-51; figure 12, item 1206; an external interface providing network connectivity to other repositories for the exchange of digital works);

means for detecting the presence of secure containers (see column 14, lines 28-33; figure 12, item 1203; description tree storage for digital works);

means for determining information regarding secure containers (see column 14, lines 35-39; figure 12, item 1203; rapid retrieval of description tree information), including;

an access condition for transmission of the secure container (see column 18, lines 33-39; figure 14, item 1456; a specification component for the digital work concerning access and security for a potential recipient for the digital work) and

controls associated with use or transmission of the secure container (see column 18, lines 33-39; figure 14, item 1457; a specification component for the digital work concerning control for the digital work).

However, Stefik et al. neither teach nor suggest information regarding secure containers including a location for the transmission of the secure container, a means for transmitting secure containers to locations designated by the secure container information, or routing information indicating that the secure containers passed through the first checkpoint. These particular features explicitly incorporated into independent claim 21 render claims 21-26 allowable.

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Claims 27-31 are drawn to a method of routing a secure container. The closest prior art, Stefik et al., U.S. Patent No. 5,629,980 A, describes a similar method.

Stefik et al. illustrate a method of routing a secure container, including governed content and having associated a rule set at least in part governing access to or other use of the governed content (see column 7, lines 9-11; figure 1, step 102; a digital work with appropriate usage rights and fees attached), including:

    sending the secure container from a sender to a first secure checkpoint (see column 7, lines 8-13; figure 1, step 102; the creator stores the digital work in Repository 1 until a request for access is received);

    at the first checkpoint, determining, based on the rule set, that the secure container is to be transmitted to a first recipient (see column 7, lines 19-26; figure 1, steps 104 and 105; Repository 1 checks the usage rights associated with the digital work to determine if the access to the digital work may be granted to Repository 2; and

    transmitting the secure container to a first recipient (see column 7, lines 31-33; figure 1, step 107; Repository 1 transmits the digital work to Repository 2).

However, Stefik et al. neither show nor imply:

    at the first checkpoint, ascertaining routing information from the rule set and determining, based on the routing information, that the first secure checkpoint is authorized to receive and transmit the secure container;

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at the first checkpoint, associating first checkpoint information with the secure container, indicating that the secure container was received by and transmitted by the first secure checkpoint;

at the first recipient, ascertaining routing information from the rule set and determining, based on the routing information, that the first recipient is authorized to receive the secure container; or

at the first recipient, determining, from the rule set that the rule set specified a required path for transmission of the secure container from the sender to the first recipient.

These particular steps explicitly incorporated in independent claim 27 render claims 27-31 allowable.

Claims 32-36 are drawn to a method. The closest prior art, Stefik et al., U.S. Patent No. 5,629,980 A, discloses a similar method.

Stefik et al. depict a method including:

generating a secure container including governed contents (see column 7, lines 8-9; figure 1, step 101; creating a digital work);

associating a rule set with the secure container, including at least one rule designed to at least in part govern access to or other use of the governed contents (see column 7, lines 9-11; the digital work with appropriate usage rights and fees attached);

transmitting the secure container from a first site to a first secure checkpoint (see column 7, lines 9-11; figure 1, step 102; storing the digital work with usage rights and fees in Repository 1); and

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transmitting the secure container to the intended recipient (see column 7, lines 31-33; figure 1, step 107; Repository 1 transmits the digital work to Repository 2).

However, Stefik et al. neither teach nor motivate:

at the first secure checkpoint, reading routing information, indicating an intended recipient of the secure container;

at the first secure checkpoint, associating a digital certificate with the secure container, including information evidencing the receipt of the secure container at the first secure checkpoint; or

at the intended recipient, reading information relating to the actual route taken by the secure container between the first site and the intended recipient; and taking action based on the actual route information.

These distinct elements explicitly recited in independent claim 32 render claims 32-36 allowable.

Claims 42-46 are drawn to a secure checkpoint. The closest prior art, Stefik et al., U.S. Patent No. 5,629,980 A, discloses a similar secure checkpoint.

Stefik et al. delineate a secure checkpoint including:

means for receiving (see column 7, lines 9-11; figure 1, step 102; storing digital works with usage rights in a repository) and transmitting (see column 7, lines 31-33; figure 1, step 107; transmitting the digital work) secure containers including content and having associated a set designed to at least in part govern use of the content (see column 7, lines 9-11; figure 1, step 102; a digital work with usage rights and fees attached); and

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means for opening secure containers to obtain access to at least a portion of the contained content (see column 8, lines 41-46; figure 4a, item 402; a printer repository for accessing a digital work to print it).

However, Stefik et al. neither depict nor suggest:

means for using the associated rule set to identify a required route for transmission of the associated secure container;

means for determining whether a secure container has followed the required route; or

means for associating information relating to whether the secure container has followed the required route.

This distinct features explicitly incorporated into independent claim 42 render claims 42-46 allowable.

Claims 47-51 are drawn to a network. The closest prior art, Stefik et al., U.S. Patent No. 5,629,980 A, describes a similar network.

Stefik et al. illustrate a network including :

a first network node including:

a secure checkpoint including means for receiving secure containers (see column 7, lines 9-11; figure 1, step 102; storing digital works with usage rights in a repository received from a creator) and means for transmitting secure containers (see column 7, lines 31-33; figure 1, step 107; transmitting the digital work); and

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a certification authority including means for issuing digital certificates required to gain access to digital works (see column 7, lines 57-61; figure 2, item 202; an authorization repository to provide a digital certificate to access digital works).

However, Stefik et al. neither show nor imply:

a secure checkpoint including means for reading information associated with secure containers to determine secure container routing information;

a certification authority including means for issuing digital certificates associated with secure containers including information indicating that the secure container was received by the secure checkpoint; or

a directory service including a memory storing address information relating to potential recipients of secure containers and means for associating recipient address information with secure containers.

These particular features explicitly recited in independent claim 47 render claims 47-51 allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Santon et al., U.S. Patent No. 5,058,162 A, disclose a method of distributing data files to recipients using an access map.
- Corbin, U.S. Patent No. 5,138,712 A, describes transmission of software license tokens from a developer site to a customer site.

### *Telephone Inquiry Contacts*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 and whose electronic mail address is [justin.darrow@uspto.gov](mailto:justin.darrow@uspto.gov). The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the



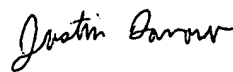
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application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only **"OFFICIAL FAX"** but also **"AMENDMENT AFTER FINAL"**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

May 28, 2004

  
JUSTIN T. DARROW  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100